

REMARKS/ARGUMENTS

Claims 14 – 25 are pending in the application.

In the Office Action, claims 14-17 and 20-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,604,329 to Reber ("Reber '329") in view of U.S. Patent No. 5,882,786 to Nassau. Claims 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reber '329 in view of Nassau, and further in view of U.S. Patent No. 5,423,714 to Lach. Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reber '329 in view of Nassau, and further in view of U.S. Patent No. 5,587,233 to Konig. Claim 25 was rejected under 35 U.S.C. 103(a) as being unpatentable over Reber '329 in view of Nassau, and further in view of U.S. Patent No. 4,725,511 to Reber ("Reber '511").

The Applicant respectfully disagrees that the cited reference combinations make obvious the subject matter of the present invention as defined in claim 14.

In contrast to the stones of the cited references, the visible surface 1 of the body of the claimed ornamental stone serves not only as a support of a structured material layer 5. Rather, this visible surface 1 also serves as a high-quality background for an image for any image motif, which is formed from the structured material layer.

Because in this regard, the visible surface 1 of the ornamental stone serves as the background of the image, the type, purity, shape, and color of the body 3 are of less importance. Instead, only a smooth visible surface 1 of the body 3 is necessary, on which the motif can be applied as the structured material layer 5. As a result, the aesthetic qualities of the ornamental stone of the present invention are provided not merely by means of the brilliance effect of the body 3, but also by

means of the effect of contrast between the stone background (the body 3) and the metallic luster of the applied motif.

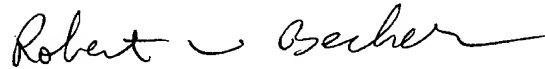
By means of the selection of the type of stone, then, an iridescent image background, in terms of color, can be maintained.

None of the cited references disclose or suggest the above features of claim 14. Specifically, the jewelry stones of the Reber '329 and Nassau references fail to have a visible surface on which a structured material layer can be applied, in the sense of the present invention and as defined specifically in claim 14. In fact, the visible surfaces themselves of the stones in the cited references have alterations in the form of depressions, in order to produce light or color effects. Or the polished surface, which is protected from damage with a coating, is made of a silicon-carbide crystal. As a result, then, the visible surfaces of the known stones are not smooth. Indeed, with the present invention, the "structure" of the material layer 5 applied on the smooth visible surface represents the image.

Based on the noted differences between the present invention and the cited references, the practitioner of ordinary skill in the art could not be led to the present invention by combining the Reber '329 and Nassau references as proposed. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ***ACS Hosp. Sys., Inc. v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). The Examiner's attention is also respectfully directed to MPEP section 2143.01. Here, both Reber '329 and Nassau fail to provide any such suggestion or incentive.

In view of the foregoing discussion, the Applicant respectfully requests reconsideration of the allowability of claim 14. In addition, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from him to discuss any outstanding issues, and in particular any further amendments to the claims to bring the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Becker", with a stylized flourish at the end.

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